



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF APPEALS AND INTERFERENCES

re. Patent Application of

Hans SJÖBLOM

Group Art Unit: 3621

Appication No. 09/423511

Examiner: Cheung, M.

§371(c) date: 10 November 1999

For: Method and Device for Performing Electronic Transactions

Reply Brief

The following counterarguments are respectfully submitted as rebuttal only to that put forth in the Examiner's Response to Argument on pages 8 and 9 of the Examiner's answer. The Claim Rejections (pages 3-8) were dealt with in the Brief in Support of Appeal submitted on 13 December 2004.

In the Examiner's Response to Argument, it is stated that in the main claim the adverb "preferably" modifies not only the phrase "through his own input of message information," but also the following limitations: " the sender, independently of any connection to a communications network and without computer dialogue with a receiver, creates, on the basis of entered transaction information, a transaction message, which contains information necessary for the transaction, the transaction message being created in the smart card with the aid of software previously stored in the smart card, and, in his smart card, provides the created transaction message with his digital signature while using his own private key for subsequent output and transmission of the transaction message. According to the Examiner, this would make all of the limitations following the word "preferably" optional features.

Firstly, it is respectfully put forth that common English syntax and punctuation permit no other construction of the wording of Claim 1 than that the adverb “preferably” only modifies the words contained within it within commas, i.e. “, preferably through his own input of message information,”. The description, (see page 5, line 29 – page 6, line 15) makes clear that there are alternatives to direct manual user input of message information, within the scope of the invention. The remaining limitations are definitely not optional and cannot be interpreted as so either syntactically or in the light of the extensive discussion with the Examiner of the wording of the main claim throughout the examination of this application.

Should, contrary to all expectations, the Examiner’s argument concerning the syntactical interpretation of the main claim prevail in this respect, meaning that there are almost no concrete non-optional limitations in the main claim beyond that known from the prior art, then this would be a new grounds for rejection, and permit “amendment appropriate to the new ground”. 37 CFR §1.193, which in this case might be even more absolutely definitive wording of this phrase or possibly a deletion of the word “preferably” altogether.

It is respectfully submitted that the Examiner’s further points of argument that “Barlow teaches using the smart card to transmit messages to the vending machine (column 14, line 59 – column 15, line 5)” is not relevant to the present subject matter since this passage only describes a known cash-card, whereby the vending machine is programmed to make a deduction from a cash chip on the smart card. The present invention as defined in independent Claim 1, relates to performing electronic transactions via a communications network, e.g. the internet, whereby the sender, entirely under his own control, creates, with software in the smartcard, a complete transactions message, without any possible security breach by contact with the insecure communications network, and then digitally signs and seals the message for subsequent transmission over the insecure communications network. The Examiner has in the Response to Argument misinterpreted the claim limitation as “**sending**

transaction messages that is independently of any connection to a communications network and without computer dialogue with a receiver”, which is patently contrary to what is stated in Claim 1 and the entire purpose of the present invention, which is to **send** transaction messages which have been created, digitally signed and sealed, in the smartcard, completely under the sender’s own control before sending the message over the insecure internet.

Although not all necessary for the soundness of our counterarguments above, we would, in any case, respectfully point out that the Examiner erroneously equates the punching in of a passcode “which is verified to the IC card” (Barlow, col. 15, line 5) to digitally signing a transaction message, which involves applying a private pass key and a hashing protocol (one-way RSA function).

As has been pointed out previously with respect to the Barlow reference, use of a cash card in a vending machine has very little to do with the completely user-controlled secure preparation in a pre-programmed smart card of a transaction message which is digitally signed by the user using a private key and is then sent to a bank for example over the internet.

The Examiner refers once again to the passage in Barlow referring to the configuration of an IC card (col. 14, lines 12-42), which, as was pointed out a number of times during the prosecution of this application, involves the very back-and-forth communication over the internet when interacting with a bank for example, which is completely avoided by the present method. This passage only describes sending passcodes and authentication certificates back and forth over the internet. The passage cited in col. 15, lines 3-10, only describes keying in, if required, a passcode, to allow cash card chip deductions to be made by a vending machine, when a user makes purchases.

Finally, we do not believe that the final cited passage from Barlow cited by the Examiner specifically with respect to Claims 21, 23 and 26 are relevant. Col. 13, lines

20-39 refer to configuration of the IC card and the addition or removal of different functionalities ("assets"), e.g. a ticket reservations function, via a resource management graphical screen. The passage in col. 14 has been discussed above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Timothy Platt', with a long horizontal flourish extending to the right.

Timothy Platt

Reg. No. 43,003

21 March 2005